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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re application of:

Willem P.C. Stemmer, *et al.*

Application No: 09/817,015

Filed: March 23, 2001

For: Methods for Modulating Cellular and Organismal Phenotypes

Examiner: Tomas H.F. Friend

Art Unit: 1639

**RESPONSE TO RESTRICTION  
AND ELECTION OF SPECIES  
REQUIREMENT**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

In Response to the Restriction Requirement mailed May 14, 2003, Applicants elect Restriction Group III, claims 74-108, without traverse. Applicants also enclose a request for an extension of time from June 14, 2003 to September 14, 2003. After entry of this Response, claims 74-108 are pending, with claims 1-73 and 109-185 being withdrawn.

For election of Restriction Groups I-III, X, and XI, the Examiner has required an election of seven categories of species. Applicants are responding to the requirement for election of species as best they can. Applicants are able to elect species for five of the seven categories of species. For the remaining two categories of species, however, it appears to Applicants that the species election would apply only to other restriction groups, and not to restriction group III. If Applicants are mistaken in this conclusion, they would appreciate further guidance from the Examiner as to how to apply the requirement of species election for these two categories of

species to Restriction Group III. Applicants' election of species are listed below, by reference to the Examiner's list on page 5 of the Office Action:

- A. Ultimate species of phenotype and ultimate species of desired phenotype: Applicants elect the complex phenotype of protein content or composition (see list in claim 26).
- B. Species of conjoint polynucleotide segment: The claims of Restriction Group III do not specify conjoint polynucleotide segments as does, for example, claim 1 in Restriction Group I. It is therefore unclear to Applicants how this species election would apply to Restriction Group III, and Applicants request further clarification from the Examiner.
- C. Ultimate species of population into which concatamers are introduced: Applicants note that the claims of restriction group III do not specify concatamers. However, Applicants believe that the Examiner probably intends for Applicants to elect a cell type into which the library of step (i) of claim 74 is introduced. Accordingly, Applicants elect the species of population to be a bacterial species (see the list in claim 105). It is unclear to Applicants if the Examiner requires further election of a particular species of bacteria. In the event this is the case, Applicants elect *E. coli* as the bacterial species.
- D. Species of identifying the ultimate species of C: Applicants elect identification of the preselected polynucleotide segments by expression analysis using at least one cDNA or oligonucleotide array.
- E. Species of conjoint polynucleotide segments: The claims of Restriction Group III do not specify conjoint polynucleotide segments as does, for example, claim 1 in Restriction Group I. It is therefore unclear to Applicants how this species election would apply to Restriction Group III, and Applicants request further clarification from the Examiner.
- F. Ultimate species of transcriptional regulatory sequence: Applicants elect a viral promoter as the transcriptional regulatory sequence.
- G. Species of identifying preselected polynucleotide segments: Applicants elect identification of the preselected polynucleotide segments by expression analysis using at least one cDNA or oligonucleotide array (see list in claim 81).

The Examiner has requested that Applicants identify the claims readable on each species election. With respect to species election for group A, claims 74 and 96 read on the election of species. With respect to species election for group C, claims 74, 99, 100, 102, and 105 read on

the election of species. With regard to the species election for group G, claims 74, 77, and 81 read on the election of the species. With regard to the remaining two groups elected (D and F), Applicants note that there are no dependent claims in Restriction Group III containing these groups of species for election. Accordingly, for species election groups D and F, the elected species are generic to all of the elected claims.

Should the Examiner believe that a telephone conference would expedite the prosecution of this application, the undersigned can be reached at the telephone number set out below. The Commissioner is hereby authorized to charge any deficiency in fees to Deposit Account No. 50-0990.

Respectfully submitted,

By:



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September 15, 2003

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